UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/807,280 | 03/24/2004 | Yoshitaka Sasaki | 119199 | 4031 |

25944 7590 01/29/2007

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

| EXAMINER | |
|---|---|
| TUGBANG, ANTHONY D | |
| **ART UNIT** | **PAPER NUMBER** |
| 3729 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 01/29/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/807,280 | Applicant(s) SASAKI ET AL. | |
|---|---|---|---|
| | Examiner A. Dexter Tugbang | Art Unit 3729 | |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED 28 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: *None*.
   Claim(s) objected to: *None*.
   Claim(s) rejected: *1-4*.
   Claim(s) withdrawn from consideration: *None*.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Attachment.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 11/21/06, 12/27/06
13. ☐ Other: _____.

A. Dexter Tugbang
Primary Examiner
Art Unit: 3729

Attachment to Advisory Action

1. The applicant(s) After Final amendment filed on December 28, 2006 has been fully considered, entered, and made of record.

2. In regards to the merits of the prior art, particularly noting the combination of Daby et al and Liu et al as applied in the last Office Action (Final Rejection, mailed on September 28, 2006), the applicant(s) appear to be arguing that the combination is improper because the track widths of the first and second magnetic pole layers of Daby are substantially the same and that this has Daby providing a transducer with an inverted write element with a zero delta in pole tip width. Because of this, Daby cannot be modified because to do so would render Daby unsuitable for its intended purpose.

The examiner most respectfully disagrees that Daby cannot by modified in light of the teachings of Liu.

The applicant(s) appear to be focused on only one intended purpose of Daby, which is to provide a magnetic transducer having a zero delta in pole tip width. However, the examiner notes that this is not the sole purpose of Daby et al and that the invention of Daby should be considered as a whole.

Daby's manufacturing process is concerned with making a magnetic transducer, or head, with first and second magnetic pole layers relative to a track width to perform the intended purpose of track writing functions. Liu is concerned with the very same intended purpose of making first and second magnetic pole layers relative to a track width to perform track writing functions. Daby et al and Liu et al manufacture art recognized equivalent magnetic heads to carry out the very same intended purpose, e.g. magnetic track writing during operation of the

magnetic head. Therefore, it is has been well settled that art recognized equivalents can be combined for performing the very same intended purpose. See MPEP § 2144.06.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art of manufacturing magnetic heads would look to the patterning method of the second magnetic pole layer of Liu et al for at least the advantage, suggestion, and motivation of reducing edge erasure from adjacent track writing.

Therefore, the examiner's position is that the combination of Daby et al and Liu et al is proper and is maintained.